

REMARKS

Based on the above amendment and the following remarks, applicant respectfully submits that all the pending claims are in condition for allowance.

Status of the Claims

Claims 1-10 were pending. Claims 1-4 have been canceled. Claims 5 and 8-10 have been amended. Claims 11-29 have been added.

Information Disclosure Statement

The examiner noted that certain references cited in the specification were not considered since they were not properly submitted in an IDS. Applicant appreciates this notice and has now rectified this deficiency.

Claim Objections

The examiner objected to claim 8 for using the term “endusers”. Applicant has amended this term to read “end users” as suggested by the examiner.

Objections to the Specification

The examiner objected to the abstract for exceeding the 150 word limit, using legal phraseology, and having certain typographical errors. Applicant has accordingly amended the abstract herein to address these issues.

The examiner further objected to the specification for having a line of extraneous material across the top of page 3. This line was in fact misplaced from a paragraph elsewhere on the page, presumably due to a software error. Applicant has attached a substitute specification that corrects this misplacement. Support for this amendment can be found on page 1 of the provisional application.

Objections to the Drawings

The examiner objected to the drawings and description for failure to include reference signs for the various features mentioned in the description. A substitute specification and corrected drawing sheets are attached hereto as required by the examiner.

Rejections Under 35 USC § 101

Claims 1-4 stand rejected as being directed to non-statutory subject matter. These claims have been canceled.

Rejections Under 35 USC § 102

Claims 1, 5, and 8-9 stand rejected under 35 USC 102(e) as being anticipated by U.S. Pat. 5,931,901 (“Wolfe”). Claim 1 has been canceled. Insofar as the remaining rejections apply to the claims as amended, applicant respectfully traverses. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.”^[1]

Among other things, amended independent claim 5 recites “providing the combined file to a user in a format that enables the combined file to be saved for later playback at the user’s convenience.” Wolfe concerns the delivery of program content and advertising using a streaming technique.^[2] Audio streams of this nature are not permitted to be saved for later playback at the users convenience, as required by the claim. For at least this reason, independent claim 5 is allowable over the cited art.

Amended independent claim 8 recites “making combined files available to end users for download to a computer”. Wolfe teaches only the use of a streaming technique, whereas independent claim 8 requires that combined files be available for downloading. For at least this reason, independent claim 8 and its dependent claim 9 are allowable over the cited art.

Rejections Under 35 USC § 103

Claims 6-7 stand rejected under 35 USC § 103(a) as being unpatentable over Wolfe. Claims 2-4 and 10 stand rejected under 35 USC § 103(a) as being unpatentable over Wolfe in view of U.S. Pat. 6,351,736 (“Weisberg”). Claims 2-4 have been canceled. Insofar as the remaining

[1] Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

[2] Wolfe at c3ℓ1-3 (“The completed data stream is then delivered to the subscriber in a single, inseparable stream of data packets over the Internet.”).

rejections apply to the claims as amended, applicant respectfully traverses because the cited art fails to teach or suggest all the claim limitations.^[3]

Claims 6-7 depend from independent claim 5, which as previously mentioned recites “providing the combined file to a user in a format that enables the combined file to be saved for later playback at the user’s convenience.” Wolfe concerns the delivery of program content and advertising using a streaming technique.^[4] Audio streams of this nature are not permitted to be saved for later playback at the users convenience. Wolfe has deliberately chosen his technique in order to accurately track advertising play time,^[5] and for that reason he fails to suggest the recited claim limitation. For at least this reason, dependent claims 6-7 are allowable over the cited art.

Claim 10 depends from independent claim 8, which as previously mentioned recites “making combined files available to end users for download to a computer”. Wolfe teaches only the use of a streaming technique, whereas independent claim 8 requires that combined files be available for downloading. Weisberg clearly discourages the use of audio advertising altogether.^[6] For at least these reasons, claim 10 is allowable over the cited art.

New Claims

Claims 11-29 have been added, and are allowable over the cited art.

Claims 11-13 depend from independent claim 8 and are allowable over the cited art for at least the same reason as claim 8.

Independent claim 14 recites “a web site having audio files available for download by web site visitors, wherein one or more of the audio files include an embedded audio message from a sponsor”. As previously mentioned, Weisberg teaches away from the use of audio advertising,

[3] MPEP § 2142 (“To establish a prima facie case of obviousness, three basic criteria must be met. ... the prior art reference (or references when combined) must teach or suggest all the claim limitations.”).

[4] Wolfe at c3ℓ1-3 (“The completed data stream is then delivered to the subscriber in a single, inseparable stream of data packets over the Internet.”).

[5] Wolfe at c2ℓ52-57 (“In effect, advertisers buy the right to have their messages played a given number of times.”). See also c5ℓ32-44.

[6] Weisberg at c2ℓ4-17.

and Wolfe does not suggest allowing downloads. For at least these reasons, independent claim 14 and its dependent claims 15-23 are allowable over the cited art.

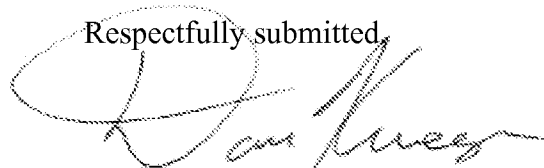
Independent claim 24 recites “downloading an audio file with an audible advertisement from a web site to a computer; and transferring the audio file from the computer to an external playing device that plays the audible advertisement when playing the audio file.” Neither Weisberg nor Wolfe teaches the use of an external playing device. For at least this reason, independent claim 24 and its dependent claims 25-29 are allowable over the cited art.

Conclusion

In the course of the foregoing discussions, applicant may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the prior art which have yet to be raised, but which may be raised in the future.

If any fees are inadvertently omitted or if any additional fees are required or have been overpaid, please appropriately charge or credit those fees to Krueger Iselin LLP Deposit Account Number 50-4305/1002-001.00/HDJK.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Daniel J. Krueger", is written over a circular stamp that contains the text "Respectfully submitted,".

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